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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,108	11/29/2000	Andrew Chien	ENTRPA.010A	6811

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EXAMINER
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WILLETT, STEPHAN F

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 05/03/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/727,108

Applicant(s)

CHIEN ET AL.

Examiner

Stephan F Willett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3,6</u> | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1, drawn to downloading an application, is classified in class 709, subclass 203.
  - II. Claims 2-23, drawn to modifying a binary of an application, are classified in class 709, subclass 225.

2. The inventions are distinct, each from the other because:
3. The claims in Group I involve steps to download an application, while the claims in Group II specifically involve monitoring and responding to network events, which is classified in a different class from Group I.
4. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as to download an application. In the instant case, invention II has separate utility such as to modify a binary. See MPEP § 806.05(d).
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
6. Because these inventions are distinct for the reasons given above and the searches required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
8. Applicant's election without traverse of claims 2-24 by Eric Nelson by telephone on March 29, 2004 is acknowledged.

*Claim Objections*

9. Claims 5 and 6 are objected to because of the following informalities: "An network" is incorrect. Appropriate correction is required.

*Claim Rejections - 35 USC § 103*

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haatainen et al. with Patent Number 6,678,734 view of Freund with Patent Number 5,987,611.
13. Regarding claim(s) 2, 14, Haatainen teaches modifying or hooking a binary or compiled code of an application, col. 13, lines 47-51; col. 15, lines 11-14 wherein binary application is broadly defined as in the applicant's specification at page 7, line 27 such that a request from the

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application to transmit data is intercepted, col. 14, lines 1-3 and the requests identifies a destination address, col. 2, lines 2-5; col. 10, lines 38-40. Haatainen teaches determining whether a packet is approved or should be allowed through, col. 7, lines 7-9. Haatainen teaches a preprocessor, col. 17, line 13. Haatainen teaches notifying a proxy or firewall or interceptor of the intercepted request, col. 1, lines 31-38. Haatainen teaches the invention in the above claim(s) except for explicitly teaching determining whether an address is in a list of approved addresses. In that Haatainen operates to modify code involved in the interception of packets in a computer network, the artisan would have looked to the network communication software data arts for details of implementing types of modifications. In that art, Freund, a related network data communication system, teaches "the system should preferably be capable of filtering incoming data, including binary files", col. 9, lines 14-15 in order to provide functionality to intercepted packets. Freund specifically teaches "a list of URLs (or WAN addresses) that a user can (or cannot) access", col. 13, lines 8-9 to insure data accessibility is secure. Further, Freund suggests "maintain[ing] a database of the access rules", col. 13, line 1 which will result from implementing different types of functions regarding intercepted packets. The motivation to incorporate address databases insures communications in today's diverse networks is checked. Thus, it would have been obvious to one of ordinary skill in the art to incorporate checking an approved database of addresses as taught in Freund into the communication system described in Haatainen because Haatainen operates with various types of functions related to intercepted data and Freund suggests that optimization can be obtained by specifically limiting access to certain resources based on packet addresses. Therefore, by the above rational, the above claims are rejected.

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14. Regarding claim(s) 3, 15, Haatainen teaches notifying a proxy or firewall or interceptor of the intercepted request, col. 1, lines 31-38; col. 7, lines 1-5 or in Freund at col. 2, lines 31-37.

15. Regarding claim(s) 4, Haatainen teaches inserting an import table or DLL in an interceptor module such that the interceptor module is invoked in response to loading or starting an application, col. 7, lines 32-38 to intercept requests based on addresses, col. 14-15, lines 15-17, 60-8.

16. Regarding claim(s) 5, 16, Haatainen teaches an accept or new request, col. 11, lines 32-37, determining whether there is an entry in the queue, col. 11, lines 54-56 and if there is no entry in the queue continue to block addresses, col. 11, lines 56-60 wherein the function will not get called to block addresses until an address is received.

17. Regarding claim(s) 6, Haatainen teaches an accept or new request, col. 11, lines 32-37 determining whether there is an entry in the queue, col. 11, lines 54-56 and if there is no entry in the queue returning a message indicating there is no entry, col. 11, lines 22-29 wherein the “complete” or “end” message indicates there are no more entries.

18. Regarding claim(s) 7, 17, Haatainen teaches a send request as a “sending function”, col. 9, lines 19-20 and writing the buffer or saved content as memory, col. 9, lines 27-29, col. 11, lines 45-48 into a send queue, col. 11, line 55.

19. Regarding claim(s) 8, 18, Haatainen teaches a receive request, col. 10, line 4 and reading the contents in a proxy table or DLL to return them to an application, col. 14-15, lines 15-17, 60-8 or in Freund at col. 31, lines 14-15, 20, 26.

20. Regarding claim(s) 9, 19, Haatainen teaches a socket request and recording the socket’s or port’s ID to the application, col. 7, lines 29-32; or in Freund at col. 19, lines 45-46.

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21. Regarding claim(s) 10, 20, Haatainen teaches a network bind request, col. 10, lines 31-33; and Freund teaches this results in, for example, obfuscating or disallowing the network address, col. 19, line 66.

22. Regarding claim(s) 11, 21, Haatainen teaches a connect or open request, col. 10, lines 60-62 and updating a status indicating that a socket, col. 7, lines 29-32 is virtually connected or unavailable, col. 12, lines 56-59.

23. Regarding claim(s) 12, 22, Haatainen teaches a listen or inspect request packets, col. 8, lines 57-60 updating a status indicating that a socket, col. 7, lines 29-32 is listening or monitoring packets or remote destinations or addresses, col. 12, lines 56-59.

24. Regarding claim(s) 13, 23, Haatainen teaches encrypting data, col. 1, lines 22-24.

### *Conclusion*

25. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure is disclosed in the Notice of References Cited. A close review of the Srivastava et al. with Patent Number 5,963,740 and Bennett et al. with Patent Number 6,049,666. The other references cited teach numerous other ways and reasons up modify a binary, thus a close review of them is suggested.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (703) 308-5230. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached on (703) 305-4003. The fax phone number for the



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organization where this application or proceeding is assigned is (703) 746-7239.

28. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9605.

A handwritten signature in black ink, appearing to read "Stephan Willett", written in a cursive style.

Stephan Willett

Patent Examiner

March 23, 2004